

I. Claim Rejections - 35 U.S.C. § 103(a)

Claims 1-20 have been rejected under 35 U.S.C. § 103(a). Applicant respectfully traverses these rejections. For a rejection to be proper under 35 U.S.C. § 103(a), the U.S. Patent and Trademark Office ("USPTO") has the burden to establish that the claim would be prima facie obvious to a person of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). First, the reference or combination of references must teach or suggest each element of the rejected claim. *MPEP* § 2143. Second, a suggestion or motivation to modify or to combine the cited references must be found in the prior art or the knowledge of a person of ordinary skill in the art, and not in Applicant's disclosure. *Id.* Third, the combination or modification must be such that a person of skill in the art would reasonably expect the combination or modification to be a success. *Id.* In the present case, a prima facie case of obviousness has not been established against Applicant's claims, as described below.

A. Rejection of Claims 1, 3, 7, 9, 13, 15, 17, and 19

Claims 1, 3, 7, 9, 13, 15, 17, and 19 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,292,211 to *Pena* ("Pena") in view of U.S. Pat. No. 5,930,479 to *Hall* ("Hall") and U.S. Pat. No. 6,298,128 to *Ramey et al.* ("Ramey"). Applicant respectfully traverses this rejection. Through this response, Applicant has amended each of the rejected claims, rendering the rejection of these claims moot. Applicant asserts that the claims as amended define over the cited combination of references, and therefore Applicant respectfully asks the Examiner to withdraw the rejections. Applicant briefly discusses the application of the cited references to Applicant's claims below.

1. Applicant's Independent Claims 1 and 7

As amended, Applicant's claim 1 provides as follows (emphasis added):

A program storage device readable by a machine and encoding a program of instructions for generating and providing access to standardized electronic mail addresses for individuals in a geographic region, comprising:

instructions operable to collect name and known location data of an individual from an information source;

instructions operable to create an at least partial entry for the individual in an index of individuals in a database, the at least partial entry being based on the collected name and known location data of the individual;

instructions operable to trigger generation of a standardized electronic mail address for the individual, including:

instructions operable to provide a personal name code indicative of the name data of the individual;

instructions operable to provide a location code indicative of the known location data of the individual; and

instructions operable to generate the standardized electronic mail address for the individual based on the personal name code and the location code;

instructions operable to submit the standardized electronic mail address for the individual to the database; and

instructions operable to search the database using the personal name code and the location code for the individual to locate the standardized electronic mail address of the individual.

Additionally, Applicant's claim 7 now provides (emphasis added):

A system for generating and providing access to standardized electronic mail addresses for individuals in a geographical region, comprising:

logic configured to collect name and known location data of an individual from an information source;

logic configured to create an at least partial entry for the individual in an index of individuals in a database, the at least partial entry being based on the collected name and known location data of the individual;

logic configured to trigger generation of a standardized electronic mail address for the individual, including:

logic configured to generate a personal name code indicative of the name data of the individual;

logic configured to generate a location code indicative of the known location data of the individual; and

logic configured to generate the standardized electronic mail address for the individual based on the personal name code and the location code;

logic configured to submit the standardized electronic mail address for the individual to the database; and

a search engine for searching the database using the personal name code and the location code to locate the standardized electronic mail address associated with the individual.

Through this response, Applicant has amended claim 1 to require “instructions operable to collect name and known location data of an individual from an information source”, and has amended claim 7 to require “logic configured to collect name and known location data of an individual from an information source”. The cited references do not teach these elements.

Additionally, the cited references do not teach or suggest the “instructions operable to create an at least partial entry for the individual in an index of individuals in a database, the at least partial entry being based on the collected name and known location data of the individual”, which is required by Applicant’s claim 1, or the “logic configured to create an at least partial entry for the individual in an index of individuals in a database, the at least partial entry being based on the collected name and known location data of the individual”, which is required by Applicant’s claim 7.

Further, the cited references do not teach or suggest “instructions operable to trigger generation of a standardized electronic mail address for the individual”, which is required by Applicant’s claim 1, or “logic configured to trigger generation of a standardized electronic mail address for the individual”, which is required by Applicant’s claim 7. The cited references also do not teach or suggest “instructions operable to submit the standardized electronic mail address for the individual to the database”, as required by Applicant’s claim 1, or “logic configured to submit the standardized electronic mail address for the individual to the database”, as required by Applicant’s claim 7.

The “instructions operable to search the database using the personal name code and the location code for the individual to locate the standardized electronic mail address of the individual” are not taught by the cited references. This element is required by Applicant’s claim 1. Further, “a search engine for searching the database using the personal name code and the location code to locate the standardized electronic mail address associated with the individual” is not taught by the cited references. This element is required by Applicant’s claim 7.

Further, Applicant maintains the previous assertion that neither Pena, Hall nor Ramey teaches the remaining elements of Applicant's claims. Specifically, Applicant's claim 1 requires "instructions operable to provide a personal name code indicative of the name data of the individual", and Applicant's claim 7 requires "logic configured to generate a personal name code indicative of the name data of the individual". The Office Action alleges that these elements are taught by the following passage of Pena:

Once the people desiring such communication have subscribed to the service and paid the designated subscription fee, each would be given a unique access code and assigned a unique e-mail address that would be added to a computer database of subscribers. Subscribers remote from one another would be able to schedule videoconferences in advance, at regular intervals where appropriate.

Immediately prior to the scheduled visual conferencing time, each subscriber or group of subscribers would be given an enclosed room by a local technician in which to conduct the visual communication in private, equipped at a minimum with a high resolution monitor, a live video capture camera, audio speakers, at least one microphone, a writing surface, and at least one piece of furniture to comfortably seat them. Set up of the computer equipment for the visual communication would be accomplished by a skilled computer technician located at each subscriber's site through the use of a central processing unit at a control station, which would most likely be used for simultaneous operation of multiple visual communication functions. In the preferred embodiment an independent e-mail station in proximity of the privacy booths but not connected directly to it, would allow subscribers to independently access written e-mail messages or still images sent to them by another subscriber, and receive a printed copy of each such message. No technician would be required. ***All the subscribers would have to do is type their unique assigned access code on a keypad***, also type the name of the intended recipient subscriber on the keypad, and then insert the written message or picture into the scanner provided. A local or networked central processing unit would access the subscriber database, determine from the database the appropriate e-mail address of the intended recipient subscriber or subscribers, direct the scanner to scan the written message, and send the scanned image to named recipient subscribers' e-mail addresses without creating a file for the image elsewhere in the computer's memory, after which it would direct the scanner to return written message or picture to the sending subscriber.

Pena; col. 4, ln. 20-54 (emphasis added). From the above, it is not clear how Pena is alleged to teach the "personal name code indicative of the name data of the individual", much less "instructions operable to provide" or "logic configured to generate" the name code. Instead, Pena appears to teach "a unique access code" that is "given" to the user, and nothing in Pena suggests the unique access code is "indicative of the name data of the individual" as required by Applicant's

claims. In fact, Pena teaches the "unique access code" is "assigned" and is typed "on a keypad", suggesting the code is a numerical sequence that would not be indicative of name data of the individual. Should the rejection be maintained, Applicant asks the Examiner to provide additional information explaining how the cited passage is alleged to teach these elements of Applicant's claims.

The Office Action further alleges that the "instructions operable to provide a location code indicative of the known location data of the individual", required by Applicant's claim 1, and the "logic configured to generate a location code indicative of the known location data of the individual", required by Applicant's claim 7, are taught in the following passage of Pena:

An Internet web site (not shown) would be provided for the communication link so that local telephone numbers can be used and long distance charges avoided, and so that other information (not shown) can be exchanged between subscribers such as the e-mail transfer of written messages and images, as well as classified ads, notices about items for sale, notices about upcoming events, descriptions of employment opportunities, and other similar types of information that can be directed toward targeted groups of recipient subscribers. In the preferred embodiment it is contemplated for visual and e-mail communication to be available on a subscription basis to family, friends, and other people remotely located from one another who would benefit from periodic visual communication so that ***once each subscriber is assigned an e-mail address and an access code, the correspondents' names, addresses, and codes are stored in a subscriber database for use by central processing unit 26 in identifying recipients of e-mail communications.*** Also, to avoid conflicts in use of privacy booths 2 by subscribers, it is contemplated for visual communications to be scheduled in advance. At the appointed time, each visual correspondent would be given an enclosed private room in which to conduct the visual communication, such privacy booth 2 shown in FIG. 1. At a minimum, it is contemplated for privacy booth 2 to be equipped with a high resolution monitor 12, a live video capture camera 10, audio speakers 8, at least one microphone 14, a writing surface 58, and at least one piece of furniture 44 that can comfortably seat one or more adults. A light, number 50 in FIG. 2, and or buzzer (not shown), along with a small window, number 46 in FIG. 2, could be installed through one of the walls of privacy booth 2 for signaling a skilled computer technician (not shown) of the need for his or her assistance, such as for the initialization of the capture of still or moving images of a remote correspondent for one or more local correspondents. Set up and activation of the visual communication equipment would be accomplished by a technician skilled in computer and electronic equipment operation through use of a central processing unit 26 at a control station 38. The amount of equipment control options within a privacy booth 2 or at an e-mail station 22, available to subscribers for adjusting the operation of the visual communication and e-mail communication equipment, would be limited to avoid subscriber mistake and resulting equipment malfunction. It is contemplated for the system of the present invention to comprise at least two control stations 38, at least one privacy booth 2 and at least one

e-mail station 22 in the vicinity of each control station 38, as well as optional remote e-mail stations 62 and 82 each placed in monitored locations, such as hotels, restaurants, or grocery stores to deter theft and vandalism. For e-mail communication, subscribers would not have to know the recipient subscriber's e-mail address, only the name of the intended recipient subscriber or identification of the group of subscribers to which the e-mail communication is directed.

Pena; col. 7, ln. 56 – col. 8, ln. 45 (emphasis added). Again, it is not clear how the above passage is alleged to teach the “location code indicative of the known location data of the individual”, much less “instructions operable to provide” or “logic configured to generate” the location code. Pena does teach adding subscriber address data to a database. However, the address data is not used to create a “location code indicative of” the address data. Should the rejection be maintained, the Applicant asks the Examiner to provide additional information explaining how the cited passage is alleged to teach these elements of Applicant’s claims.

Regarding the assertion in the Office Action that the claims “do not even define what the personal name code and location code is”, Applicant respectfully disagrees. Office Action; pg. 7. Applicant’s claims require instructions operable to, or logic configured to, “collect name and known location data of an individual from an information source”, to “provide a personal name code indicative of the name data”, and to “provide a location code indicative of the known location data”. Applicant asserts these elements define “what the personal name code and location code is”.

The Office Action also alleges Pena teaches instructions operable to, or logic configured to, “generate an electronic mail address for an individual”. Office Action; pg. 6. In support of that proposition, the Office Action cites the following passage of Pena:

FIG. 6 shows the necessary and optional steps in one preferred embodiment of the present invention for the conduct of e-mail transmission and retrieval between database subscribers, as well as visual conferencing between subscribers that includes capture of remote correspondent images and the secure transfer of money between visual correspondents. To use the present invention, two technicians each skilled in computer and electronic equipment operation, and each in a location remote from the other, would set up a central processing unit 26 and connect it to a printer/scanner/fax unit 40, a live video capture camera such as camera 10, microphones 14, video recording equipment such as VCR 34, speakers 8, a high resolution monitor 12, an e-

mail station 22, 62, or 82 having optional coin/credit card/debit card activation, an optional automated teller machine 60, an optional scanner 86, a printer 18, keypad 68 for data input, and a display screen 98, the system also having Internet access to a web site programmed to provide subscriber e-mail communication. After **the technicians** set up and make the visual and e-mail communication systems operational, they would **use the central processing unit 26 and the web site to create a database of subscribers who want to send written e-mail messages** and pictorial images to other database subscribers, as well as conduct visual conferences with other subscribers, **in addition to creating an e-mail address for each such subscriber, and assigning each such subscriber a unique system access code**. Once a subscriber decides that he or she would like to communicate with another subscriber, the subscriber would decide if a visual conference, an e-mail transmission, e-mail receipt, or a combination thereof is desired. If only e-mail transmission and receipt is desired and the subscriber does not want help from a technician at a control station 38, the sending subscriber could choose to approach a remote e-mail station, such as wall-mounted e-mail station 62 or stand-alone e-mail station 82.

Pena; col. 13, ln. 39-66 (emphasis added). The above passage of Pena does not appear to teach "instructions operable to...generate the... electronic mail address for the individual", as required by Applicant's claim 1, or "logic configured to...generate the... electronic mail address for the individual", as required by Applicant's claim 7. Instead, the electronic mail address in Pena appears to be generated by "technicians" who "create a database of subscribers...in addition to creating an email address for each such subscriber", while Applicant's claim requires a "program storage device" comprising "instructions operable to" perform this function, or a "system" comprising "logic configured to" perform this function. Should the rejection be maintained, the Applicant asks the Examiner to provide additional information explaining how the cited passage is alleged to teach this element of Applicant's claims.

Further, it should be noted that Applicant's claim 1 requires "instructions operable to...generate the standardized electronic mail address for the individual based on the personal name code and the location code", and Applicant's claim 7 requires "logic configured to generate the standardized electronic mail address for the individual based on the personal name code and the location code". The Office Action admits that Pena does not teach or suggest these elements as claimed, and seeks to correct this deficiency with Hall and Ramey. Specifically, the Office Action alleges that "Hall discloses a well-known concept of using

standardized mail addresses". In support of that proposition, the Office Action cites the following passage of Hall:

A preferred embodiment of the present invention utilizes "channelized addresses" to allow correspondents to send and receive e-mail. Channelized addresses create different "channels" that correspondents can use to send e-mail to the user. In other words, each user's e-mail account is made accessible via a user-controlled set of channels. ***Each channel has a distinct structured e-mail address that contains within it the account name and a cryptographically unpredictable or "unguessable" random string, known as a "channel identifier."*** Each legitimate correspondent is allowed to know one or more of these access addresses or channel identifiers.

The system according to the invention allows the user to reject any e-mail not arriving on a proper channel (with a proper channelized address). If unwanted e-mail does arrive on a valid channel, the user may turn the channel off and allow legitimate users of that channel to use another channel. In other words, legitimate users are "switched" to another channel.

The user (or account owner) is provided simple controls for opening a new channel, closing a channel (hence possibly retracting one or more correspondent's access privilege), and switching a channel (notifying selected correspondents that the current channel is being closed, but a new one is open for their use). This can be provided through an automated personal channel agent ("PCA"). The PCA also causes the received channelized e-mail to look and feel to the user exactly like conventional e-mail. The PCA provides various administrative controls. The PCA manages a database that maps a correspondent's address to its assigned channel, as well as (when applicable) the channel assigned by the correspondent to the account owner.

Hall; col. 5, ln. 5-38 (emphasis added). As an initial matter, the Office Action appears to be relying on Hall to teach the single word "standardized" in Applicant's claims. Applicant fails to see the relevance of Hall to Applicant's claims. Specifically, the email addresses taught by Hall do not appear to be "standardized". Instead, the email addresses taught by Hall are "cryptographically unpredictable" as a result of an "'unguessable' random string" contained within the address.

Even if the above cited passage is sufficient to teach "standardized" electronic mail addresses, which Applicant maintains is not so, Hall does not teach "standardized electronic mail address for the individual based on the personal name code and the location code", as required by claims 1 and 7. The Office Action admits this deficiency and seeks to correct it with Ramey, alleging "Ramey discloses a well-known concept of using electronic mail address

based on the personal name code and the location code.” Office Action; pg. 6. Applicant respectfully disagrees. The cited passage of Ramey states:

In the e-mail mode, the processor 110 accesses the e-mail server by dialing the telephone number of that server, in a known manner. E-mail messages for the user are retrieved, and stored in the RAM 126, also in the message portion 128. ***Each e-mail message includes identification information, including the e-mail address and e-mail name of the originator of the message. Other e-mail information relating to that message may also be included, such as the date and time the message was sent, the location from which it was sent, routing information, etc.*** The e-mail identification information is also stored with the message in the message portion 128 of the RAM 126. ***The e-mail information is also inserted into the database*** of correspondent information 130, maintained in a portion 130 of the RAM 126 in a manner to be described in more detail below.

When a message is received, the identification information relating to that message (e.g. originating telephone number and name for telephone messages and originating e-mail address and e-mail name for e-mail messages, and possibly other related information) is stored in a common database, as referred to above. In this manner the content of the database is maintained.

FIG. 2 is a table describing the structure and contents of a database used to contain correspondent information in the communications device illustrated in FIG. 1. The structure of the correspondent database is represented in FIG. 2 as a table.

Each row of the table represents an entry in the correspondent database and represents one correspondent. Each entry contains a plurality of fields able to hold information relating to the correspondent represented by that entry. The fields are partitioned into: a group of fields able to contain caller ID information including the telephone number, caller ID name, and other attributes (represented by an ellipsis) related to the telephone for that correspondent; a group of fields able to contain e-mail identification information including the e-mail address, e-mail name, and other attributes (represented by an ellipsis) related to e-mail of that correspondent; and a group of fields able to contain extensions to the correspondent information, including, for example, the facsimile telephone number, postal address and other such information (represented by an ellipsis).

Ramey; col. 5, ln. 5-38. The cited passage of Ramey does not teach or suggest a standardized email address based on a personal name code and location code. Instead, Ramey appears to teach “inserting” certain “email message...identification information” into “a database”. The information includes “email name of the originator” and “possibly the location from which [the email] was sent”. Nothing in Ramey suggests the “email name of the originator” is a “personal name code” that is “indicative of the name data of the individual”. In fact, email addresses often bear no relationship to the name of the individual sending the message. Further, nothing in Ramey suggests the “location from which [the email] was sent” is a “location code” that is

indicative of “the known location data of the individual”. In fact, the location from which the email is sent may be inconsistent with the known location data of the individual. Even if the “email name of the originator” is a “personal name code” and the “location from which [the email] was sent” is a “location code”, Ramey does not appear to teach “a standardized email address based on a personal name code and location code”. In Ramey, the “email name of the originator” and the “location from which [the email] was sent” are pieces of “email message...identification information” that are added to a database table, and not elements on which a standardized email address is based.

For at least the reason that none of the cited references teach or suggest the elements of Applicant’s claims discussed above, Applicant asserts that claims 1 and 7 are allowable over Pena in view of Hall and Ramey. Therefore, Applicant respectfully asks the Examiner to withdraw the rejection.

Further, Applicant submits that the combination of references is improper for at least the reason that Hall appears to teach away from generating email addresses “based on the personal name code and the location code”. Instead, Hall is apparently directed to restricting unwanted or undesirable e-mail by incorporating the “cryptographically unpredictable or ‘unguessable’ random string” into the email address. On the contrary, Applicant’s “standardized email address” is “based on the personal name code and the location code”, so that “the personal name code and location code” can be used “to locate the standardized email address of the individual” by searching a “database”. The Office Action states:

Applicant’s assertion that Hall reference is teaching away is simply incorrect, as the Hall references provide more than one systems and/or methods and different types electronic mail addresses that can be handled which does not mean that they teach away, because Hall provides and/or discloses alternatives that can be used.

Office Action; pg. 4. If Hall does disclose alternatives that do not teach away from Applicant’s claims, Applicant asks the Examiner to specifically cite the passages of Hall that teach these alternatives so that Applicant can substantively respond.

2. Applicant's Dependent Claims 3, 9, 13, 15, 17 and 19

Claims 13 and 17 have been canceled through this response, rendering the rejections of those claims moot. For at least the reason that claims 3, 13, and 15 depend from claim 1, and claims 9, 17, and 19 depends from claim 7, Applicant asserts these claims are allowable over the cited combination of references, and respectfully asks the Examiner to withdraw the rejection.

B. Rejection of Dependent Claims 2 and 8

Claims 2 and 8 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Pena, Hall, and Ramey in view of U.S. Pat. No. 6,897,985 to *Toyoda* ("Toyoda"). Applicant respectfully traverses this rejection. Claim 2 is allowable over the cited combination of references for at least the reason that this claim depends from claim 1, and claim 8 is allowable over the cited combination of references for at least the reason that this claim depends from claim 7. Therefore, Applicant asserts a prima facie of obviousness has not been made against Applicant's claims 2 and 8, and Applicant respectfully asks the Examiner to withdraw the rejection.

C. Rejection of Dependent Claims 4 and 10

Claims 4 and 10 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Pena, Hall and Ramey in view of U.S. Pat. No. 6,097,797 to *Oseto* ("Oseto"). Applicant respectfully traverses this rejection. Claim 4 is allowable over the cited combination of references for at least the reason that this claim depends from claim 1, and claim 10 is allowable over the cited combination of references for at least the reason that this claim depends from claim 7. Therefore, Applicant asserts a prima facie of obviousness has not been made against Applicant's claims 4 and 10, and Applicant respectfully asks the Examiner to withdraw the rejection.

D. Rejection of Dependent Claims 5 and 11

Claims 5 and 11 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Pena, Hall and Ramey in view of U.S. Pat. No. 6,707,472 to *Grauman* ("Grauman"). Applicant respectfully traverses this rejection. Claim 5 is allowable over the cited combination of references for at least the reason that this claim depends from claim 1, and claim 11 is allowable over the cited combination of references for at least the reason that this claim depends from claim 7. Therefore, Applicant asserts a prima facie of obviousness has not been made against Applicant's claims 5 and 11, and Applicant respectfully asks the Examiner to withdraw the rejection.

E. Rejection of Dependent Claims 6, 12, 14, 16, 18, and 20

Claims 6, 12, 14, 16, 18 and 20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Pena, Hall and Ramey in view of Official Notice. In support of the Official Notice, the Office Action cites U.S. Pat. No. 5,970,469 to *Scroggie et al.*, U.S. Pub. No. 2005/0125546 to *Pennell et al.*, U.S. Pub. No. 2001/0034609 to *Dovolis*, U.S. Pat. No. 6,292,211 to *Pena*, U.S. Pat. No. 6,874,023 to *Pennell et al.*, and U.S. Pub. No. 2001/0047391 to *Szutu*. Applicant respectfully traverses this rejection. Claims 6, 14, and 16 is allowable over the cited combination of references for at least the reason that this claim depends from claim 1, and claims 12, 18 and 20 are allowable over the cited combination of references for at least the reason that these claim depends from claim 7. Therefore, Applicant asserts a prima facie of obviousness has not been made against Applicant's claims 6, 12, 14, 16, 18 and 20, and Applicant respectfully asks the Examiner to withdraw the rejection.

II. Canceled Claims

Through this response, claims 13 and 17 have been canceled from the application without prejudice, waiver, or disclaimer. Applicant reserves the right to present the canceled claims, or variants of the canceled claims, in subsequently filed continuing applications.

III. New Claims

Through this response, claims 21 and 22 have been added to the application. Applicant asserts that the new claims are novel and are not obvious in view of the prior art of record. Therefore, Applicant respectfully asks the Examiner to allow these claims.

CONCLUSION

Applicant respectfully asks the Examiner to withdraw the outstanding rejections, and to allow issuance of the application and pending claims. Further, Applicant invites the Examiner to call the Applicant's undersigned counsel at (770) 933-9500 if the Examiner believes a telephone conference would expedite the examination of this application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Scott A. Horstemeyer', is written over a horizontal line.

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